

REMARKS

Reply to Notice of Non-Compliant Amendment

The aforementioned Notice states that it is in response to the document filed on 6 November 2007. The 6 November 2007 document was considered non-compliant because it failed to meet the requirements of 37 C.F.R. 1.121 or 1.4. The amendments were objected to because they did not contain proper status identifiers. In a continuation sheet, the Examiner indicated that the 6 November submission was marked as "Proposed Claims" and that a second copy of the original claims was also submitted. The Examiner stated further that it "appears that applicants have filed the 'Proposed Points of Discussion' from the interview and the "Proposed Claims" instead of filing amended claims [*with*] proper status identifiers and Arguments."

The 6 November submission, as the title states, was a set of "Proposed Claims" and "Proposed Points of Discussion" for the Examiner's benefit in preparation for and prior to the telephone interview of 7 November 2007. The 6 November 2007 submission was not intended to replace the claims then pending. Applicants filed a Request for Continued Examination (RCE), Request for Extension of Time and Supplemental Information Disclosure Statement on 6 December 2007. To clarify the status of the claims, applicants submit herewith the listing of the claims substantially as they were filed on March 23, 2007 in Reply to the Office Action of October 23, 2006. The status identifiers are believed to be proper because the "Proposed Amendments" submitted 6 November 2007 were not intended at that time to replace the then pending claims.

Applicants submit that the claims presented herein are in proper format. Withdrawal of the Notice of Non-Compliant Amendment is respectfully requested.

Response to Office Action mailed June 13, 2007

In the Office Action mailed June 13, 2007, the Examiner rejected claims 16-18 under 35 U.S.C. §112, second paragraph as being indefinite. Claim 16 has been

amended to remove the method step. Claims 17-18 depend from claim 16 and include its limitations. Withdrawal of the rejection of claims 16-18 under 35 U.S.C. §112, second paragraph is respectfully requested.

The Examiner rejected claims 1-12 and 14-18 under 35 U.S.C. § 103(a) as being unpatentable over Goldberg et al., U.S. Publication 2001/0041335 in view of Schwartz et al., U.S. Patent No. 4,609,689. The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Goldberg in view of Schwartz and further in view of Mirkin et al., U.S. Patent No. 6,582,921.

Applicants respectfully traverse the rejection of claims 1-12 and 14-18 as being obvious over the Goldberg and Schwartz and of claim 13 as being obvious over the Goldberg, Schwartz and Mirkin.

Applicants note that the Patent and Trademark Office recently updated the MPEP in light of the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007). The MPEP contains guidelines for determining obviousness under 35 U.S.C. §103 ("Guidelines"). The Guidelines reiterate that the framework for the objective analysis for determining obviousness lies in *Graham v. John Deer Co.* Obviousness is a question of law based on three underlying factual inquiries:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art. See MPEP 2141(II).

The Guidelines recite the following:

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references combined) need not teach or suggest all claim limitations; however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art...The gap between the prior art and the claimed invention may not be "so great as to render the [claims] nonobvious to one reasonably skilled in the art." MPEP 2141(III) (emphasis added).

Applicants composition provides high throughput, high sensitivity multiplex data using dual, triple or greater fluorochromes. Such a multiplex analysis of RNA expression profile is not suggested or described in any of the references. Further, the applicants' composition provides vastly increased sensitivity (greater than 100 fold in some instances) and large multiplex capabilities (i.e., the ability to measure over 100 analytes in a single run), which the cited references do not disclose or suggest. Applicants submit that these results are unexpected in view of the cited references.

Applicants submit that the differences between applicants' composition and the teachings of the cited references are therefore so great as to render the claims nonobvious to one reasonably skilled in the art. Reconsideration of the claims and withdrawal of the rejections under 35 U.S.C. § 103(a) are respectfully requested.

Conclusion


In view of the above, applicants respectfully submit that each of the issues raised by the Notice and the Office Action of June 13, 2007 has been addressed.

Reconsideration and allowance of each of the pending claims is respectfully requested.

If the undersigned can be of assistance to the Examiner in addressing issues to advance the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted,

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Date:


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